

Certificate of Mailing

I hereby certify that on May 8, 2003, this correspondence and any attachments are being deposited with the United States Postal Service as First Class Mail, postage pre-paid, in an envelope addressed to: Mail Stop Appeal Brief - Patent, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

Jennifer D. Ahearn
Jennifer Ahearn

PATENT
Atty. Docket No. 31045-7

#24
Brief
6:10pm
5/16/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

ALBERT SILVERA

Serial No.: 09/268,412

Filed: March 15, 1999

For: TECHNIQUE FOR DECORATING A
SHOE AND A SHOE DECORATED
USING THE TECHNIQUE

Group Art Unit: 3728

Examiner: J. Mohandesi

TECHNOLOGY CENTER R3700

MAY 15 2003

RECEIVED

**APPELLANT'S BRIEF
ON APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Mail Stop Appeal Brief - Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

Appellant in the above-captioned patent application appeals the final rejection of claims 1, 2, 4 to 9, 11 to 19, 21 and 22 set forth in the Office Action mailed November 20, 2002, a timely Notice of Appeal having been filed on February 14, 2003.

05/13/2003 CNGUYEN 00000138 09268412

02 FC:1402

320.00 DP

0522433.1

I. REAL PARTY IN INTEREST

The real party in interest in this application is Dynasty Footwear, Ltd., having a place of business at 800 N. Sepulveda Blvd., El Segundo, California 90245-2702, pursuant to an assignment which was recorded at reel 9834, frame 0105 on March 15, 1999.

II. RELATED APPEALS AND INTERFERENCES

Appellant appealed the Examiner's previous rejections pursuant to an Appeal Brief filed on October 11, 2000. The Board of Patent Appeals and Interferences reversed those rejections in a Decision on Appeal that was mailed on October 30, 2001. Subsequently, the Examiner reopened prosecution and made the present rejections.

III. STATUS OF CLAIMS

Claims 1, 2, 4 to 9, 11 to 19, 21 and 22 have been finally rejected and are the subject matter of this appeal. Claims 3, 10 and 20 have been canceled. In accordance with 37 C.F.R. § 1.192(c)(9), a copy of the claims involved in this appeal is included in Appendix A attached hereto.

IV. STATUS OF THE AMENDMENTS

No amendments have been filed subsequent to the final rejection.

V. SUMMARY OF THE INVENTION

The present invention is directed to decorating shoes, such as sports shoes or children's shoes, and is specifically concerned with decorating a shoe with stick-on tattoos.

It is quite common for manufacturers to include various decorative designs on the shoes that they manufacture. Unfortunately, most such designs are permanently printed or sewn onto the shoe. As a result, in order to display a different design, a customer typically must purchase a different shoe bearing the desired design. Clearly, this can be costly and often impractical.

Responding to the problem, various approaches have been proposed to provide shoes having decorations that can be customized by the end user. In one, adhesive-backed stickers are applied to a shoe. Unfortunately, such stickers usually cannot be easily removed from the shoe, thus often resulting in a permanent decoration of the shoe once applied. In addition, the adhesive used on such stickers may even damage the shoe.

In another approach, such as is described in U.S. Patent 4,697,362 (Wasserman), decorative elements are attached to a shoe using a hooked material on the decorative elements and a looped material on the shoe (commonly known under the trademark Velcro). While allowing for the possibility of subsequent alterations of the decorative arrangement, this approach has its own problems. For instance, use of Velcro generally means that the decorative article will protrude somewhat from the surface of the shoe, thus increasing the likelihood that the decorative article will be pulled off if another object rubs against the shoe. In addition, use of a Velcro fabric on a shoe often will tend to trap lint and other unwanted materials, making it difficult to keep the shoe clean.

The present invention addresses the foregoing problems by providing a shoe decorating technique and a decorated shoe in which a stick-on tattoo that does not include separate adhesive material is applied to a smooth outer surface of the shoe. See Figure 2, reference number 102; page 7, lines 12 to 15; and page 7, lines 20 to 21, of the Specification. By using such a stick-on tattoo as the decorative article and by applying the tattoo to a smooth outer portion of the shoe in this manner, the present

invention allows a shoe to be decorated and re-decorated with relatively little effort, while typically ensuring that the decorative article remains on the shoe until it is desired to be removed. At the same time, a shoe decorated according to the present invention generally will be easier to keep clean than a shoe that requires a Velcro surface.

It is noted that a variety of "tattoos" are available commercially. Some use adhesive backing and therefore are simply one type of what is commonly known as a sticker. As described below, the product sold by Creative Crystal™, although marketed as a "tattoo", actually does not appear to be a tattoo at all; rather, it appears to consist of a number of adhesive-backed crystal rhinestones.

Another class of tattoos, those used in the present invention and termed "stick-on tattoos", do not rely upon separate adhesive backing. These types of tattoos typically adhere by taking advantage of the different properties that the tattoo material exhibits when wet, as compared with the material's dry state. Because no adhesive is used, the types of materials to which such stick-on tattoos will reliably adhere often is much more limited than is the case with adhesive-backed tattoos. Moreover, of those materials to which such nonadhesive stick-on tattoos will so adhere, the number of materials from which such stick-on tattoos may be removed with relative ease when desired is even more limited. As a result, the use of such nonadhesive-backed stick-on tattoos conventionally has been limited mainly to application to skin.

Nevertheless, Appellant has discovered that such a nonadhesive-backed stick-on tattoo can be effectively applied to a shoe and then later relatively easily removed if a sufficiently smooth surface is provided. At the same time, any potentially damaging or toxic effects of using a tattoo having separate adhesive material can be avoided.

In the present invention, the smooth surface to which the stick-on tattoo is attached preferably is comprised of polyvinyl chloride (page 5, lines 17 to 19), but in any event preferably allows the stick-on tattoo to be removed with no more than moderate effort by only scratching with a fingernail, even after adhering to the shoe for

more than one month (page 8, lines 4 to 8). In other aspects of the invention, the smooth surface to which the stick-on tattoo is applied is either clear or white (page 5, lines 21 to 23), thereby allowing better visibility of the stick-on tattoo.

VI. ISSUES PRESENTED ON APPEAL

The issues are: (i) whether claims 1, 2, 4 to 9, 11 and 15 to 19, 21 and 22 are properly rejected under 35 U.S.C. § 103(a) over a Web page for "Creative Crystal" (hereafter, "Creative Crystal") in view of the packaging label for "SkinWear Temporary Tattoos" (hereafter, "SkinWear") or vice versa; and (ii) whether claims 12 to 14 are properly rejected under § 103(a) over Creative Crystal and SkinWear in view of U.S. Patent 4,697,362 (Wasserman).

VII. GROUPING OF THE CLAIMS

In the Office Action, the Examiner grouped the claims in a particular manner. However, upon reviewing the applied art and the grounds for rejection set forth in the Office Action, Appellant has determined that the claims are more appropriately grouped as follows:

GROUP 1: Claims 1, 2, 9, 11, 16, 18 and 19

GROUP 2: Claims 4 and 15

GROUP 3: Claim 5

GROUP 4: Claim 6

GROUP 5: Claim 7

GROUP 6: Claim 8

GROUP 7: Claims 12 to 14

GROUP 8: Claim 17

GROUP 9: Claims 21 and 22

As explained below, each of the above groups is believed to be separately patentable over the applied art. In particular, each identified group recites at least one additional, non-obvious feature that provides an additional reason why each claim in such group is not rendered obvious by the applied art.

VIII. ARGUMENT

DISCUSSION OF ISSUES ON APPEAL

The requirements for establishing a *prima facie* case of a § 103 rejection have been stated as follows.

"a proper analysis under § 103 requires, inter alia, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. [citing In re Dow Chemical Co., 837 F.2d 469, 473, 5 U.S.P.Q.2D 1529, 1531 (Fed. Cir. 1988).] Both the suggestion and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure."

In re Vaeck, 947 F.2d 488, 493 (Fed. Cir. 1991).

Thus, MPEP § 2142 requires that in order to establish a *prima facie* case of obviousness, the Examiner must cite prior art references that teach or suggest all of the claim limitations and, if more than one such reference is required to disclose all such limitations, there must be some suggestion or motivation, either in the prior art references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings.

As discussed below, the above requirements for establishing a *prima facie* case of obviousness have not been met for any of the following groups of claims.

Group 1 Claims

Independent claim 1 is directed to technique for decorating a shoe by wetting a stick-on tattoo and applying it to a smooth outer surface of the shoe. Independent claim 11 is directed to a decorated shoe with a stick-on tattoo attached to a smooth portion of the outer surface of the shoe. In each case, the stick-on tattoo does not include separate adhesive material and is applied to (or adheres to) the shoe without using separate adhesive material.

The applied art does not disclose or suggest the foregoing combinations of features. In particular, the applied art does not disclose or suggest at least the feature of a stick-on tattoo that does not include separate adhesive material adhering to a smooth outer surface of a shoe without the use of separate adhesive material.

To the contrary, the "tattoos" sold by Creative Crystal actually are "crystal rhinestones backed with a medical adhesive specially formulated for use on human skin". The foregoing quotation is taken from the same Web site from which the Creative Crystal Web page cited by the Examiner was taken. A copy of the Web page that includes this quotation was provided to the Examiner in the Amendment/Response that was filed on August 22, 2002, and an additional copy is attached as Appendix B hereto.

Thus, while the Creative Crystal reference discloses attaching its "tattoos" to a shoe, it is apparent that these "tattoos" are in fact significantly different than the tattoos according the present claims. In fact, the Creative Crystal "tattoos" do not appear to be tattoos at all, according to the ordinary definition of that term.

Moreover, there simply is no suggestion in the Creative Crystal reference to use any type of nonadhesive-backed stick-on tattoo in any manner whatsoever. To the

contrary, the primary teaching of Creative Crystal is the application of crystal rhinestones as decorative items, and it most likely would not even be possible to apply rhinestones as described in Creative Crystal without the use of a separate adhesive.

Conversely, while the cited SkinWear reference discloses the use of tattoos of the type used in the present invention, the SkinWear reference does not suggest the use of its tattoos on anything other than skin. Accordingly, no permissible combination of Creative Crystal and SkinWear would have suggested applying the presently claimed type of stick-on tattoo to a shoe.

The Examiner argues that Creative Crystal teaches the application of artificial tattoos for the purposes of decoration, and that this teaching would have motivated one skilled in the art to apply a SkinWear tattoo to a shoe. However, the mere fact that Creative Crystal calls its adhesive-backed rhinestones "tattoos" does not alter the fact that they are fundamentally different, and have significantly different applicability, than the SkinWear tattoos and the type of tattoos used in the present claims. Due to these substantial differences, it is not believed that there would have been any motivation to combine Creative Crystal and SkinWear in any manner whatsoever, much less as indicated by the Examiner.

Furthermore, because Creative Crystal is advertising its own crystal rhinestones, it must be inferred that the sole purpose of that reference is to promote those items over any possible alternatives, thereby teaching away from the use of any type of tattoo or other decorative article. As previously mentioned, it is not believed that Creative Crystal's rhinestones could be applied without the use of a separate adhesive. Conversely, one having a SkinWear tattoo would not look to a reference pertaining to adhesive-backed crystal rhinestones for guidance as to where to apply the SkinWear tattoo.

In addition to the suggestion to provide the recited feature, a proper § 103 rejection requires that the teaching of a "reasonable expectation of success must be

found in the prior art, not in the applicant's disclosure." In re Vaeck, *supra*. For the reasons set forth above, the applied art would not have suggested the present claims. However, even if the applied art were found to supply the requisite motivation to try, nothing in any permissible combination of Creative Crystal and SkinWear would have led to a reasonable expectation of succeeding in applying a nonadhesive-backed stick-on tattoo to a shoe.

To the contrary, while adhesive-backed stickers can adhere to almost any surface, the same is not true of the stick-on tattoos of the present invention. In fact, the types of surfaces to which nonadhesive-backed stick-on tattoos will adhere is very limited. That probably is the reason that the SkinWear reference does not even suggest attempting to apply its tattoos to anything other than skin.

Supporting these observations is a declaration of the present inventor that was submitted to the Examiner in the Amendment/Response that was filed on August 22, 2002. A copy also is attached as Appendix C hereto (the "Inventor's Declaration").

The inapplicability of nonadhesive-backed stick-on tattoos is shown in paragraph 3 of the Inventor's Declaration. In that paragraph, the inventor states that his experiments showed that a nonadhesive-backed tattoo rarely will adhere to a conventional shoe.

Only after a significant amount of effort did the inventor finally realize that the solution to this problem was to apply a nonadhesive-backed tattoo (e.g., of the type sold by SkinWear) to a smooth surface of the shoe. In paragraph 5 of the Inventor's Declaration, the inventor further notes that very few conventional shoes have such a smooth surface.

As a result, it is not believed that any permissible combination of Creative Crystal and SkinWear would have conveyed to one of ordinary skill in the art any reasonable expectation of success in applying the presently claimed type of stick-on tattoo to a shoe.

Finally, nothing in Creative Crystal, in SkinWear or in any combination of the two teaches or suggests seeking out a smooth surface of a shoe for applying a tattoo, as recited in the present claims. In fact, the Examiner has not even alleged that the applied art shows this feature of the invention, but instead merely asserts the unsupported conclusion that one of ordinary skill in the art would have applied the tattoo of the present invention to any surface that would have accepted it. Such a conclusory statement is easy to make in hindsight, based on Appellant's own disclosure. However, there is nothing in any permissible combination of Creative Crystal and SkinWear that would have either suggested application of the recited stick-on tattoo to such a smooth surface or would have taught a reasonable expectation of success in doing so, as is required by In re Vaeck, *supra*. In addition, as evidenced by the Inventor's Declaration, such a conclusion is directly contradicted by the amount of inventive effort actually required to solve the problem, once the present inventor decided to attempt to try applying nonadhesive-backed stick-on tattoos to shoes.

Lacking both a suggestion and an indication of a reasonable expectation of success, it is not believed that any permissible combination of Creative Crystal and SkinWear could have rendered independent claims 1 or 11 obvious. Accordingly, independent Claims 1 and 11, and their dependent claims 2, 9, 16, 18 and 19, are believed to be allowable over the applied art.

Group 2 Claims

Claims 4 and 15 depend from claims 1 and 11 (in Group 1), respectively, and recite the further limitation that the smooth portion of the outer surface of the shoe to which the stick-on tattoo is applied is comprised of polyvinyl chloride (PVC). This limitation is not disclosed or suggested by the applied art.

At the outset, it is noted that very few shoes have outer surfaces comprised of PVC. Therefore, without some specific motivation, it is not believed that one would seek out a PVC surface for application of stick-on tattoos.

In this regard, Creative Crystal does not appear to be very particular about the surfaces to which its decorative items are applied. This most likely is because Creative Crystal's use of a medical adhesive will permit such items to be applied to a wide variety of surfaces. In any event, Creative Crystal certainly does not suggest applying its decorative items to an outer surface of a shoe comprised of PVC.

SkinWear only mentions application of its tattoos to skin and therefore also says nothing at all about application of stick-on tattoos to a PVC surface of a shoe. Thus, it is believed that none of the applied art, either alone or in combination would have disclosed or suggested this feature of the invention.

The Examiner asserts that use of a PVC surface on a shoe is common, and therefore it would have been obvious to apply tattoos as recited in the present claims to such a surface. Appellant disagrees with this assertion, and the Examiner has not cited any prior art that would show that use of a PVC surface on a shoe was common at the time of the present invention. Rather, the Examiner cites only two examples of shoes (from the tens of thousands of shoes on the market) that are made using PVC. This is quite different than showing that use of PVC was so common that it would have been obvious to apply a tattoo according to the present convention on a smooth PVC surface of a shoe.

Absent such a showing, it cannot be said that applying the tattoos of the present invention to such a surface (particularly when they do not adhere to most other types of shoe surfaces) would have been an obvious alternative or a matter of design choice, as asserted by the Examiner. It is therefore believed that a *prima facie* case of obviousness (in accordance with In re Vaeck, *supra*) has not been made out with respect to claims 4 and 15.

For these additional reasons, claims 4 and 15 are believed to be allowable over the applied art.

Group 3 Claim

Claim 5 depends from independent claim 1 (in Group 1) and recites the further limitation that the stick-on tattoo is removed from the shoe and a second stick-on tattoo is applied to the shoe. With regard to this limitation, the Examiner merely asserts that this would have been obvious and well within the ordinary skill of the ordinary skilled worker if the first tattoo is desired to be replaced.

However, as shown in paragraph 4 of the Inventor's Declaration, once a tattoo of the present invention adheres to a conventional shoe it is usually very difficult to remove it from the shoe without damaging the shoe. Thus, when applying such a tattoo to a conventional shoe there would have been no practical motivation to subsequently remove it and apply another. Only through the present invention's use of the appropriate surface of a shoe is this impediment overcome. However, there is no teaching or suggestion in the prior art that one should seek out such a surface in order to facilitate removal of a tattoo and application of a replacement.

For these additional reasons, claim 5 is believed to be allowable over the applied art.

Group 4 Claim

Claim 6 depends from independent claim 1 (in Group 1) and recites the further limitation that the stick-on tattoo is applied to a portion of the outer surface of the shoe that is white. This additional feature of the invention is not disclosed or suggested by the applied art.

In this regard, the Examiner simply asserts that smooth white surfaces are common on shoes and therefore this feature of the invention would have been an obvious alternative or a matter of design choice. Appellant disagrees with the assertion that smooth white surfaces are common on shoes, and no reference has been cited to show that such surfaces are common.

Rather, Appellant believes that such surfaces are uncommon and that one would have had to actively seek out such a surface. However, the prior art provides no motivation to do so. Instead, that motivation is only present in Appellant's own patent application specification, which of course cannot provide the grounds for an obviousness rejection.

For these additional reasons, claim 6 is believed to be allowable over the applied art.

Group 5 Claim

Claim 7 depends from independent claim 1 (in Group 1) and recites the further limitation that the stick-on tattoo is applied to a portion of the outer surface of the shoe that is clear. This feature of the invention is not disclosed or suggested by the applied art.

In this regard, the Examiner simply asserts that smooth clear surfaces are common on shoes and therefore this feature of the invention would have been an obvious alternative or a matter of design choice. However, Appellant disagrees with the assertion that smooth clear surfaces are common on shoes, and no reference has been cited to show that such surfaces are common.

Rather, Appellant believes that such surfaces are uncommon and one would have had to actively seek out such a surface. However, the prior art provides no motivation to do so. Instead, that motivation is only present in Appellant's own patent application specification, which of course cannot provide the grounds for an obviousness rejection.

For these additional reasons, claim 7 is believed to be allowable over the applied art.

Group 6 Claim

Claim 8 depends from independent claim 1 (in Group 1) and recites the further limitation that the stick-on tattoo can be removed with no more than moderate effort by only scratching with a fingernail even after adhering to the shoe for more than one month. The Examiner asserts that this limitation would have been inherent in or obvious from the use of the SkinWear tattoo.

However, as shown in paragraph 4 of the Inventor's Declaration, once a tattoo of the present invention adheres to a conventional shoe it is usually very difficult to remove it from the shoe without damaging the shoe. Thus, removal of a tattoo as recited in claim 8 generally would not have been possible when the tattoo was applied to a conventional shoe. Only through the present invention's use of an appropriate surface of a shoe is this limitation made possible. However, there is no teaching or suggestion in the prior art that one should seek out such a surface in order to facilitate removal of a tattoo and application of a replacement.

For these additional reasons, claim 8 is believed to be allowable over the applied art.

Group 7 Claims

Claims 12 to 14 depend from independent claim 11 (in Group 1) and recite the further limitation that the smooth portion of the outer surface of the shoe to which the stick-on tattoo adheres is disposed within a recessed portion of the shoe. This additional feature of the invention is not believed to be disclosed or suggested by the applied art.

The Examiner cites Wasserman as showing the use of a recessed portion into which a decorative Velcro "plug" is inserted, and then asserts that it would have been obvious to use such a recessed portion for attaching a tattoo according to the present invention. However, Wasserman clearly states that the purpose of his recessed portion is so that the surfaces of the plug will be flush with the surface of the shoe, thereby

providing a uniform appearance and the illusion that the design is integrally constructed into the shoe and inherent in the molding of the shoe sole. See, e.g., column 2, lines 60-68. To achieve this desired result, a recessed portion is necessary because the Velcro plug used in Wasserman has a substantial thickness.

On the other hand, tattoos according to the present invention often will be much thinner and, as a result, often will not require a recessed portion to achieve the appearance of a uniform surface. In fact, the use of a recessed portion for displaying such tattoos might mean that the tattoo itself is recessed relative to the remainder of the shoe's immediately surrounding surface area. Therefore, the feature that the smooth portion of the outer surface of the shoe to which the stick-on tattoo adheres is disposed within a recessed portion of the shoe could not have been obvious in view of any permissible combination of Creative Crystal, SkinWear and Wasserman.

For this additional reason, claims 12 to 14 are believed to be allowable over the applied art.

Group 8 Claim

Claim 17 depends from independent claim 11 (in Group 1) and recites the further limitation that the smooth portion of the outer surface of the shoe approximately matches the stick-on tattoo in size. This feature is not disclosed or suggested by the applied art. Instead, the Examiner merely concludes that such a feature would be an obvious matter of design choice well within the skill of the ordinary skilled worker if so desired. However, no prior art reference has been cited by the Examiner to support this assertion.

It is noted that Creative Crystal teaches the arbitrary placement of its crystal rhinestones on various articles, such as shoes. Based on that disclosure, the Examiner argues (with respect to the Group 1 claims) that it would have been obvious to attach a stick-on tattoo according to the present invention to a shoe. As to the present claims, however, the Examiner is asserting that matching the size of the stick-on tattoo to the

size of the smooth portion of the shoe, or vice versa, would have been an obvious design choice. However, this is significantly beyond even the arbitrary placement of tattoos on a shoe argued by the Examiner, generally requiring the customization of either or both of the tattoo and the shoe in order to match each other.

There simply is no teaching in the applied art that would have suggested this feature of the invention. As a result, it is believed that a *prima facie* case has not been made out with respect to this claim.

For this additional reason, claim 17 is believed to be allowable over the applied art.

Group 9 Claims

Claims 21 and 22 depend from claims 1 and 11 (in Group 1) and recite the further limitation that the smooth portion of the outer surface of the shoe is comprised of plastic. This limitation is not disclosed or suggested by the applied art.

At the outset, it is noted that very few shoes have outer surfaces comprised of plastic. Therefore, without some specific motivation, it is not believed that one would seek out a plastic surface for application of stick-on tattoos.

In this regard, Creative Crystal does not appear to be very particular about the surfaces to which its decorative items are applied. This most likely is because Creative Crystal's use of a medical adhesive will permit such items to be applied to a wide variety of surfaces. In any event, Creative Crystal certainly does not suggest applying its decorative items to an outer surface of a shoe comprised of plastic.

SkinWear only mentions application of its tattoos to skin and therefore also says nothing at all about application of stick-on tattoos to a plastic surface of a shoe. Thus, it is believed that none of the applied art, either alone or in combination would have disclosed or suggested this feature of the invention.

The Examiner asserts that use of a plastic surface on a shoe is common, and therefore it would have been obvious to apply tattoos as recited in the present claims to

such a surface. Appellant disagrees with this assertion, and the Examiner has not cited any prior art that would show that use of a plastic surface on a shoe was common at the time of the present invention. Rather, the Examiner cites only two examples of shoes (from the tens of thousands of shoes on the market) that are made using plastic. This is quite different than showing that use of plastic was so common that it would have been obvious to apply a tattoo according to the present convention on a smooth plastic surface of a shoe.

Absent such a showing, it cannot be said that applying the tattoos of the present invention to such a surface (particularly when they do not adhere to most other types of shoe surfaces) would have been an obvious alternative or a matter of design choice, as asserted by the Examiner. It is therefore believed that a *prima facie* case of obviousness (in accordance with In re Vaeck, supra) has not been made out with respect to claims 21 and 22.

For these additional reasons, claims 21 and 22 are believed to be allowable over the applied art.

CONCLUDING REMARKS

As Appellant has shown above, for a number of reasons, nothing in the cited references discloses, teaches, or suggests the inventions recited by the claims on appeal. Appellant therefore respectfully submits that the claimed invention is patentably distinct over the applied art.

Serial No.: 09/268,412

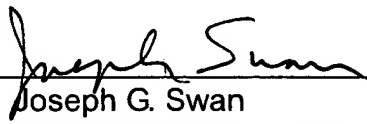
In view of the foregoing, Appellant respectfully requests that the rejection of claims 1, 2, 4 to 9, 11 to 19, 21 and 22 be reversed and a Notice of Allowance issued.

Respectfully submitted,

MITCHELL, SILBERBERG & KNUPP LLP

Dated: May 8, 2003

By



Joseph G. Swan

Registration No. 41,338

MITCHELL, SILBERBERG & KNUPP LLP
11377 West Olympic Boulevard
Los Angeles, California 90064
Telephone: (310) 312-2000
Facsimile: (310) 312-3100

APPENDIX A

Claims on Appeal

1. A method for decorating a shoe, comprising:
wetting a stick-on tattoo; and
applying the stick-on tattoo to a smooth portion of an outer surface of the shoe,
wherein the stick-on tattoo does not include separate adhesive material, and
wherein the stick-on tattoo is applied to the shoe without using separate adhesive material.
2. A method according to claim 1, wherein the stick-on tattoo is comprised of a combination of a copolymer and a polyester resin.
3. CANCELED
4. A method according to claim 1, wherein the smooth portion of the outer surface of the shoe is comprised of polyvinyl chloride (PVC).
5. A method according to claim 1, further comprising steps of removing the stick-on tattoo from the shoe and applying a second stick-on tattoo to the shoe.
6. A method according to claim 1, wherein the stick-on tattoo is applied to a portion of the outer surface of the shoe that is white.
7. A method according to claim 1, wherein the stick-on tattoo is applied to a portion of the outer surface of the shoe that is clear.
8. A method according to claim 1, wherein the stick-on tattoo can be removed with no more than moderate effort by only scratching with a fingernail even after adhering to the shoe for more than one month.
9. A method according to claim 1, wherein the stick-on tattoo is comprised of a film-like material.
10. CANCELED
11. A decorated shoe, comprising:
a shoe having an outer surface which includes a smooth portion; and
a stick-on tattoo attached to the smooth portion of the outer surface of the shoe,
wherein the stick-on tattoo does not include separate adhesive material and
adheres to the shoe without use of separate adhesive material.

Serial No.: 09/268,412

12. A decorated shoe according to claim 11, further comprising a recessed portion, wherein the smooth portion of the outer surface of the shoe is disposed within the recessed portion.
13. A decorated shoe according to claim 12, wherein the recessed portion has an average width of at least 1.2 centimeters.
14. A decorated shoe according to claim 12, wherein the recessed portion has a surface area in excess of 10 square centimeters.
15. A decorated shoe according to claim 11, wherein the smooth portion of the outer surface of the shoe is comprised of polyvinyl chloride (PVC).
16. A decorated shoe according to claim 11, wherein the stick-on tattoo is comprised of a combination of a copolymer and a polyester resin.
17. A decorated shoe according to claim 11, wherein the smooth portion of the outer surface of the shoe approximately matches the stick-on tattoo in size.
18. A decorated shoe according to claim 11, wherein the smooth portion of the outer surface of the shoe is stitched into the outer portion of the shoe.
19. A decorated shoe according to claim 11, wherein the stick-on tattoo is comprised of a film-like material.
20. CANCELED
21. A method according to claim 1, wherein the smooth portion of the outer surface of the shoe is comprised of plastic.
22. A decorated shoe according to claim 11, wherein the smooth portion of the outer surface of the shoe is comprised of plastic.

Serial No.: 09/268,412

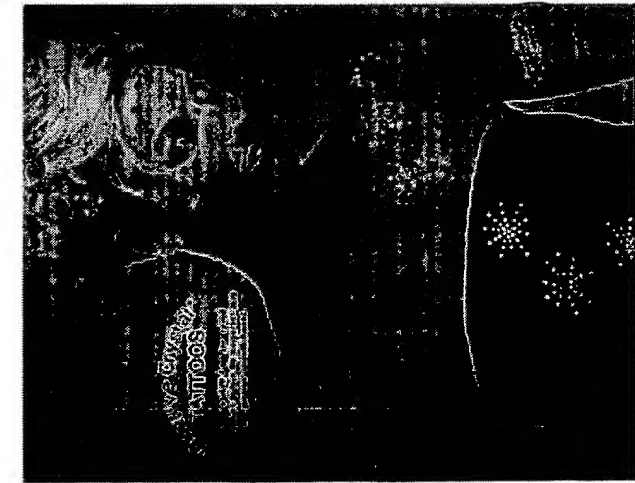
APPENDIX B

Creative Crystal Web Page

Creative Crystal™

Austrian Crystal Iron-On Rhinestones, Pearls & Metal Trims

[HOME](#) | [SHOP](#) | [HELP](#) | [SEARCH](#)



*The original Swarovski Austrian
crystal rhinestone tattoo
For Skin, Fabrics and Accessories*

SCROLL HERE TO GO SHOPPING



Named the "hottest new fashion item" at the Cannes Film Festival 2000. Worn by movie stars, recording artists, models and now available to you! Designed specifically for use on skin, tattoos also can be used as a temporary embellishment on fabrics, accessories and home decor.

The perfect temporary tattoo. Made with Swarovski® 10ss clear crystal rhinestones backed with a medical adhesive specially formulated for use on human skin. Simply peel off the white protective film and place the tattoo on skin or item to be decorated. Complete directions included. Available in the most popular designs.

Creative Tattoo Ideas!

VIEW COMPLETE SELECTION & PURCHASE

NEW ! Huge price reduction in progress !

Wholesale customers please register at our [NEW wholesale site](#) or e-mail us now for details on products for your store.

Excellent product with fantastic potential.

Email: tattoos@creative-crystal.com

**THE PERFECT GIFT
FOR THAT SPECIAL
SOMEONE**

*Holiday and Gift
Packaging now
available*

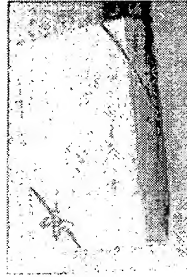


Designer shoes with rhinestones \$180 and up -
Your shoes trimmed with Crystal Tattoos less than \$12.00.
Use Line Tattoos for anklets, toe rings, bracelets, armbands and much more.
Click below for more ideas.

Creative Tattoo Ideas

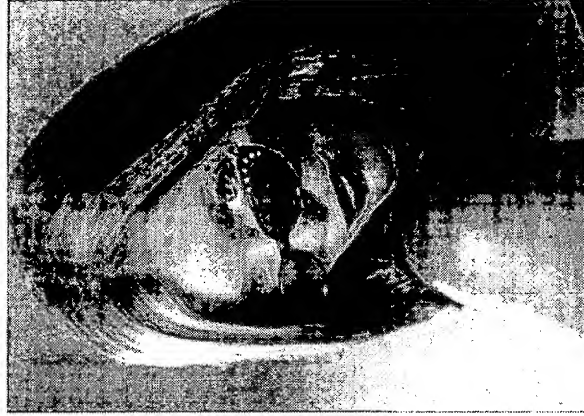


Clean skin thoroughly with soap and water, then dry. For longest wear, clean skin with alcohol and dry. Carefully remove white plastic backing and discard.
Tattoo will be held in place on clear film.



GIFT BOXED TATTOOS

We will package your choice of tattoo (or kit) in a gloss white, embossed jewelry box with gold seal and elastic tie with bow.
Includes alcohol wipe.
Choose gift package option below your choice of tattoo(s).



The hot look this year! Rhinestone sunglasses - Designer version \$450 and up -
Your glasses trimmed with Creative Crystal Line Tattoos less than \$12.00



Place tattoo on clear, dry skin or item to be decorated. Allow to "warm" for approximately 10 seconds.



Slowly peel off clear film - replace backing and press again if any stones are not firmly on skin.



Your tattoo can be easily removed from skin (do not wear for more than 2 days).
Rhinestones are held in place by a special medical adhesive

CLICK HERE TO PURCHASE TATTOOS.

Wholesale customers e-mail us now for details on products for your store. Excellent product with fantastic potential.

Email: tattoos@creative-crystal.com

Creative Crystal Company

6222 Tower Lane - Suite B-7 • Sarasota, FL 34240

Sales 1.800.578.0716 • Customer Service 1.941.377.5008

FAX 1.941.377.8047 * E-mail: crystal@creative-crystal.com

All materials © 1997-2002 Creative Crystal™ Co. (div. Haute Mode, Inc.)

Any reproduction without the written express permission of Creative Crystal™ Company is strictly prohibited.

Serial No.: 09/268,412

APPENDIX C

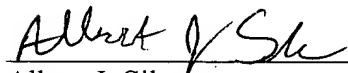
Inventor's Declaration

Declaration of Inventor Traversing Rejection

I, Albert J. Silvera, hereby declare as follows:

1. I am the inventor under U.S. Patent Application Serial No. 09/268,412, filed on March 15, 1999, titled "Technique for Decorating a Shoe and a Shoe Decorated Using the Technique".
2. Prior to my conception of the present invention, I conceived the idea of applying non-adhesive-backed tattoos to shoes as a technique for decorating and re-decorating shoes. I therefore began experimenting using SkinWear brand temporary tattoos, which are comprised of a film-like material that includes a combination of a copolymer and a polyester resin.
3. Upon experimentation, I discovered that attempts to apply non-adhesive-backed tattoos to conventional shoes usually failed. More specifically, I discovered that such tattoos rarely adhered to conventional shoes.
4. In addition, in the rare cases when I was able to get a non-adhesive-backed tattoo to adhere to a shoe it was usually very difficult to remove it from the shoe without damaging the shoe. This was a particular problem when the tattoo had been on the shoe for a long period of time.
5. After more experimentation with different types of materials and under different conditions, and also after studying the problem further, I discovered that the key to providing good adhesion while permitting relatively easy removal was to use a smooth surface. In this regard, upon close inspection it will be observed that most conventional shoes have significant surface roughness and/or irregularities, even when appearing smooth to the naked eye or feeling smooth to the touch.
6. I discovered that a good material for overcoming the aforementioned problems is a smooth polyvinyl chloride (PVC) or other smooth plastic. A shoe having a smooth PVC piece stitched onto its outer surface was constructed for testing. The non-adhesive backed tattoo applied easily to the PVC portion of the outer surface of the shoe. Then, even after a long period of time, such as more than a month, the tattoo could be removed with only moderate effort by scraping with a fingernail or by washing with water alone or water in combination with soap.
7. Still further experimentation showed that the colors of most non-adhesive-backed tattoos showed best against a clear or white background.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.


Albert J. Silvera

August 20, 2002